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09/823,654	03/30/2001	Horia Balog	10048.00	8557

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DORSEY & WHITNEY, LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
370 SEVENTEENTH STREET  
SUITE 4700  
DENVER, CO 80202-5647

EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 06/28/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/823,654

Applicant(s)

BALOG ET AL.

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-36 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-36 are presented for examination.
2. Claims 14 and 17-20 are objected to because the following terms lack antecedent basis:
  - In claim 14, "said communication protocols";
  - In claim 18, "said hierarchical protocol list";
  - In claim 18, "said best suited protocol";
  - In claim 20, "said hierarchical device list"; and
  - In claim 20, "said best suited device".
3. Claims 20-21 and 36 are objected to because of the following issues/informalities:
  - In claim 20-21, the numeral "1" appears to be redundant.
  - In claim 36, the phrase "method claim" appears to be a typo of "method of claim".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 7, 9, 16, 22-23, 25-27 and 29-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al.[U.S. Pat. No. 6463462].

6. As to claim 1, Smith teaches the invention as claimed including: a method of delivering content from a service provider to a plurality of users [Fig.1], with each user having at least one mobile device [col.12, lines 28-35; e.g., pagers or cellular phones are mobile devices] in a communication network, said method having the steps of: associating said content with a plurality of data types [Abstract; i.e., the fax, email, or pager/telephone messages are associated with its own data types];

associating each user with a global profile [e.g., the database in Fig.8] having the characteristics of said at least one device and user attributes to said service provider [e.g., col.2, lines 52-60; col.14, lines 45-53];

selecting at least one device being best suited to receive said content; and selecting a communication protocol for transport of said data type in accordance with said global profile and said data type [Figs. 20-22; col.4, lines 36-57; col.11, lines 29-42.

Note that each message type is associated with a best-suited device and a

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communication protocol. For example, a fax message would require a fax machine using a facsimile communication protocol].

7. As to claim 7, Smith further teaches the step of associating each user with a global profile includes a further step of said user specifying said characteristics of said at least one device and user attributes to said service provider [Figs. 1-4].

8. As to claims 9, 16 and 22, since the features of these claims can also be found in claims 1 and 7, they are rejected for the same reasons set forth in the rejection of claims 1 and 7 above.

As for the additional feature in claim 9 requiring "dynamically determining an optimal communication protocol for transmission of said content to said user device in accordance with said user profile, said device profile and said data type:" it is noted that Smith's optimal communication protocol is inherent to the best-suited device that has been entered in the database.

9. As to claim 25, Smith further teaches that content distribution to said users is initiated by said service provider in accordance with said user preferences [col.4, lines 36-57].

10. As to claim 26, Smith further teaches that the protocol selector includes a personalization server and a device characteristic server for storing said global profiles [e.g., UN server, Fig.1].

11. As to claim 27, Smith further teaches that said target selector includes a mobility server monitoring said network parameters such as traffic data and Quality of Service (QoS), and delivering said content accordingly [col.11, lines 59-67].

12. As to claim 29, Smith further teaches that said global profile having a plurality of user profiles, target profiles, service profiles and target characteristics [230 – 240, Fig.8].

13. As to claim 31, Smith further teaches that said devices communicate with each other via a communication protocol allowing interoperability between similar or dissimilar devices [e.g., email is used as a default for communicating among a wide variety of devices].

14. As to claims 23, 30 and 32, since the features of these claims can also be found in claims 1, 9, 22 and 31, they are rejected for the same reasons set forth in the rejection of claims 1, 9, 22 and 31 above.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 2-6, 10-15, 17-21, 24, 28 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.(hereafter "Smith")[U.S. Pat. No. 6463462], as applied to claims 1, 7, 9, 16, 22-23, 25-27 and 29-32 above.

17. As to claims 2-5, Smith teaches a database design containing various items for profiling the recipients and devices [See e.g., Fig.8 and its relevant text]. Further, Smith teaches a profile manager providing a user to enter the various attributes or settings. As such, it is obvious that Smith's database is open for update or modification when different devices characteristics or its related operational condition/environments are needed [col.11, lines 17-28].

Thus, even though Smith's exemplified database does not include all the characteristics of a device and the user attribute as listed in claim languages, they are considered either inherent parameters (such as supported network protocols) or design options, because to ensure successful operation of Smith's system in various environments (e.g., working at home, office, or traveling), Smith's system must be adapted to use various devices (e.g., devices from desktop to mobile) and utilizing their respective protocols for communications.

18. As to claims 10-11, Smith teaches that the messages can be delivered in suitable formats for respective recipient devices such as pager (i.e., audio/text), fax (e.g., bit image for any type of data content -- transaction data, enterprise data), telephone (e.g., voice) and email (text or any type of attachments). Smith DSNT that the messages also include video files, video streams, multimedia streams, etc.

However, it is well known that emerging devices such as videophones (which requires video streaming) are potential substitutes for telephones. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate new devices such as video phones as Smith's additional option for message delivery, because by doing so Smith's system/method can be widely utilized.

19. As to claim 14, Smith teaches forming a device list [see Fig.21, note that the list is hierarchical in nature because it is in the form of a file tree] wherein each device corresponds to a profile [col.9, lines 4-24]. Smith does not specifically teach a step of



dynamically determining communication protocol based on the list creating a hierarchical list of protocols.

However, since each message type is associated with a best-suited device and a communication protocol, it is obvious that a hierarchical protocol list is, in essence, embedded in the hierarchical device list and the selection of an optimal protocol is also tied directly to the selection of best-suited device, which is judged based on the importance of message, scheduled device availability, etc [col.11, lines 29-42].

20. As to claims 12 and 33, Smith does not specifically teach that said step of associating said content with a plurality of data types further involves the step of associating said data types with an optimal application profile and a BLUETOOTH protocol.

However, it is obvious that working environment relying on short-range wireless communication is becoming popular. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Smith's system/method to be extended to the wireless end-users who use BLUETOOTH protocol, IEEE 802.11 standard, the IrDA standard or the HomeRF shared wireless access protocol (SWAP), because such extension would allow Smith's system to become more widely utilized.

21. As to claims 6, 13, 15, 17-21, 24, 28 and 34-36, since the features of these claims can also be found in claims 1-3, 5, 9-10, 12, 14, 16, 22-23 and 33, they are

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rejected for the same reasons set forth in the rejection of claims 1-3, 5, 9-10, 12, 14, 16, 22-23 and 33 above.

22. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Guck [U.S. Pat. No. 5911776];

Ogasawara [U.S. Pat. No. 6512919];

Brodigan [U.S. Pat. No. 6467090];

24. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (703)305-4875. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)872-9306 for official communications; and

(703)746-5516 for status inquires draft communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Wen-Tai Lin

June 23, 2004

*Wen-Tai Lin*  
6/23/04